

REMARKS

Claims 1-10 were pending in this application. In response to the Office Action dated July 17, 2003, claims 1, 5, 8, 9 and 10 have been amended and claims 2-4 have been canceled. New claims 11-14 have been added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, figures and claims. Applicants submit that the present Amendment does not generate any new matter issue.

Initially, Applicants acknowledge, with appreciation, Examiner Foreman's courtesy and professionalism in conducting a personal interview on October 22, 2003, during which the present Amendment was discussed. Applicants submit that the present Amendment addresses the Examiner's concerns about the relative position of the electrodes with respect to the housing and its structure. Moreover, for the reasons set forth *infra*, Applicants submit that the present claims are in condition for allowance.

Claims 1-4 were rejected under 35 U.S.C. § 102(e) as being anticipated over Cha (U.S. Pat. No. 6,256,532). Applicants respectfully traverse the rejection. Claims 2-4 have been canceled and, therefore, the rejection is moot with respect to these claims. Moreover, claim 1, as amended, is free from the applied art for the reasons outline below.

Claims 1 and 2 were rejected under 35 U.S.C. § 102(e) as being anticipated over Sunako (U.S. Pat. No. 6,551,257). Applicants respectfully traverse the rejection. Claim 2 has been canceled and, therefore, the rejection is moot with respect to this claim. Moreover, claim 1, as amended, is free from the applied art for the reasons outline below.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the apparatus disclosed by Cha or Sunako that would preclude the factual determination that either reference identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claim 1 describes a bioelectrical impedance measuring apparatus. The apparatus comprises an upper housing, a lower housing and an intermediate housing between the upper and lower housing. A plurality of rod-like electrode members, each having a plurality of electrodes, are disposed in the upper housing. The upper housing comprises an upper and lower edge and two side edges, and the plurality of rod-like electrode members have a shape and a length such that persons of differing heights can maintain the same posture when grasping the electrode members. The rod-like electrodes are arranged and fixed lengthwise along both side edges of said upper housing. The apparatus also comprise a display device having the capability of an operator panel and lying between the electrode members and a weighing device included in a lower part of the housing. The housing accommodates a current supplying device for supplying current to the

electrodes, a voltage measuring device for measuring voltage at the electrodes; and an arithmetic means for calculating a bioelectrical impedance value from the supplied current value and the measured voltage values. It is noted that independent claim 8 include the limitations of claim 1 as well as a modem and a display device for displaying information which is acquired over an internet accessed through the modem.

Cha discloses a horizontal hands bar 16 containing electrodes 1, 2, 3 and 4, wherein the horizontal hands bar 16 is mounted below the display and the measuring person adjusts the horizontal bar by way of the rotating and sensing means 12. See Cha at Fig. 3(a). In contrast, the apparatus of present claim 1 includes rod-like electrodes that are arranged and fixed lengthwise along both side edges of said upper housing. The plurality of rod-like electrode members each have a shape and a length such that persons of differing heights can maintain the same posture when grasping the electrodes. See page 7, lines 21-24 of the present application. This is an important feature of the claimed invention because it enables the apparatus to accurately measure the bioelectrical impedance of users of different heights, since measurement errors caused by a change in posture due to a difference in height are minimized. Cha neither teaches nor fairly suggests the structure of the apparatus of claim 1 and, therefore, the rejection should be withdrawn.

Sunako discloses a bioelectrical impedance measuring apparatus with a handgrip. The grip section of the handgrip is provided with electrodes and the handgrip is connected to the apparatus 1 via wires. See Sunako at Figs. 1 and 5. Thus, Sunako neither discloses or suggests rod-like electrodes that are arranged and fixed lengthwise along both side edges of said upper housing. Accordingly, the rejection should be withdrawn.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Cha (U.S. Pat. No. 6,256,532) in view of Clark (U.S. Pat. No. 6,280,396). Applicants respectfully traverse the rejection for the reason set forth below.

Claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cha (U.S. Pat. No. 6,256,532) in view of Mault (U.S. Pat. No. 6,478,736). Applicants respectfully traverse the rejection for the reason set forth below.

Claims 6, 7 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cha (U.S. Pat. No. 6,256,532) in view of Mault (U.S. Pat. No. 6,478,736) and further in view of Kolawa et al. (U.S. Pat. No. 6,370,513). Applicants respectfully traverse the rejection for the reason set forth below.

Independent claim 8 discloses, in part, rod-like electrodes that are arranged and fixed lengthwise along both side edges of said upper housing. In contrast, Cha discloses a horizontal hands bar 16 containing electrodes 1, 2, 3 and 4, wherein the horizontal hands bar 16 is mounted below the display and the measuring person adjusts the horizontal bar by way of the rotating and sensing means 12. See Cha at Fig. 3(a). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants submit that there is no teaching, suggestion, or motivation to modify the apparatus of Cha to produce the claimed invention. Moreover, the secondary references (Clark, Mault and

Kolawa), either alone or in combination with Cha, fail to teach or suggest every limitation of present claim 8. Accordingly, the rejections are not legally viable and should be withdrawn.

Applicants submit that independent claim 11 and dependent claims 12-14 are patentable over the cited references since none of the references disclose or remotely suggest a plurality of rod-like electrode members, each having a plurality of electrodes, disposed in the upper housing, wherein the plurality of rod-like electrode members extend outwardly from both side edges of the upper housing in an arc-shape over the top surface of the upper housing. See Fig. 8 of the present disclosure.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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